



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/220,962	12/28/1998	BRIAN CRUICKSHANK	81749-2	5390

26345 7590 02/19/2003

GIBBONS, DEL DEO, DOLAN, GRIFFINGER & VECCHIONE
1 RIVERFRONT PLAZA
NEWARK, NJ 07102-5497

EXAMINER

SING, SIMON P

ART UNIT	PAPER NUMBER
----------	--------------

2645

DATE MAILED: 02/19/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/220,962

Applicant(s)

CRUICKSHANK ET AL.

Examiner

Simon Sing

Art Unit

2645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 November 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-77 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-77 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 11.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

1. Claim 73 are rejected under 35 U.S.C. 102(e) as being anticipated by Picard et al. US 6,233,318.

Picard discloses a multi-media messaging system in figures 1-6 (column 3, lines 33-62; column 7, lines 13-19). Picard teaches notifying a recipient of a stored message (column 3, lines 50-51), announcing a sender's name [information signal] to the recipient [transmitting to a communication device associated with the addressee of the stored message] (column 7, lines 20-23, 29-45). Pacard further teaches that audio message can be sent to the recipient in sound wave (column 18, lines 35-42).

Art Unit: 2645

2. Claims 1, 2, 16, 21, 23, 32, 34, 43, 56, 57, 66 and 71 are rejected under 35 U.S.C. 102(e) as being anticipated by Dawson US 6,252,588.

2.1 Regarding claims 1, 34 and 56, Dawson discloses a method and apparatus for providing an audio-visual e-mail system. Dawson teaches generating an information signal [visual display] relating a stored voice message to a sender's [source] thumbnail picture [graphical image] and transmitting the information signal to a communication device associated with an addressee of the stored voice message (Figure 10; column 9, lines 49-52; column 16, lines 56-67).

2.2 Regarding claims 2, 16 and 57, as discussed above, Dawson teaches including a sender's picture the information signal.

2.3 Regarding claims 21, 43 and 66, Dawson teaches transmitting the stored voice message to the addressee upon request (column 17, lines 9-16, 55-63).

2.4 Regarding claim 23, Dawson teaches a sender keeps a database of thumbnail pictures of recipients (column 15, lines 5-15).

2.5 Regarding claims 32 and 71, Dawson teaches that the sender pre-selects the thumbnail picture (column 13, lines 1-6, 13-18).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 2, 5-22, 31,34, 36-46, 48, 50-54, 56, 57, 60-67, 73 and 74 are rejected under 35 U.S.C. 103(a) as being unpatentable over Greco et al. US 5,568,540 in view of Dawson US 6,252,588.

3.1 Regarding claims 1, 34, 56 and 73, Greco discloses a voice mail system for screening the source of a stored message in figures 1 and 2. The call processor 38, acting as a server, generates a message list and each entry in the list is an information signal associated with the source of a stored message, and transmits said information signal to a client computer 14 [communications device of an addressee] (column 3, lines 63-67) for display as shown in the second and the fifth columns in figure 2 (column 4, lines 45-51 and 57-59). The information signal generated by the Greco reference includes the source's name (if the caller is a registered user), telephone number, date and time, and types of the message such as voice, fax and e-mail.

Greco fails to teach including a graphical image in the information signal.

However, Dawson discloses a method and apparatus for providing an audio visual e-mail system. Dawson teaches selecting a thumbnail picture or a sender

Art Unit: 2645

(column 20, lines 51-56), embedding the thumbnail picture [graphical image] in the header of an e-mail, and the thumbnail picture is displayed to a recipient so that the sender can be identified immediately without opening the e-mail (column 9, lines 49-52; column 20, lines 56-61).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Greco's system with the teaching of Dawson so that a thumbnail picture of a sender would have been embedded in a header of an e-mail message to identify a sender and the picture would have been displayed next to an entry of an e-mail in a message list, because such a modification would have enabled a recipient to identify a sender immediately without opening a message, and thus would have avoided being affected by computer virus or worms.

3.2 Regarding claim 2, 16, 44, 45, 46 and 57, the Greco reference, modified by Dawson, teaches including a thumbnail picture of the sender in the information signal as discussed above.

3.3 Regarding claims 5, 31 and 60, the Greco reference, modified by Dawson, Greco further teaches transmitting the information signal to a client computer 14, which is connected to a network (figure 1; column 3, lines 26-31).

3.4 Regarding claim 6, the Greco reference, modified by Dawson, the client computer 14 receives the message list, which notifies a user that stored messages have been received.

3.5 Regarding claim 7, the Greco reference, modified by Dawson, Greco further teaches storing a message list for subsequent retrieval by client computer 14 (column 2, lines 19-24; column 3, lines 32-40).

3.6 Regarding claim 8, the Greco reference, modified by Dawson, Greco further teaches generating the information signal after a message has been received (figure 2).

3.7 Regarding claims 9-11 and 62-64, the Greco reference, modified by Dawson, Greco further teaches determining the source of a message, including a caller's telephone number, name and graphical image [thumbnail picture] (figure 2).

3.8 Regarding claims 12, 13 and 15, as discussed above in claim 1, the Greco reference, modified by Dawson, teaches selecting [requesting] a thumbnail picture of a sender from the sender's computer [networked device associated with the source] and embedding the thumbnail picture in a header of an e-mail.

3.9 Regarding claim 14, the Greco reference, modified by Dawson, teaches storing a message in server 38 and generating a information signal as in figure 2.

3.10 Regarding claims 17-20, 48 and 65, the Greco reference, modified by Dawson, Greco further teaches determining the media type of each message and generating a graphical image in the information signal (column 2, lines 19-24; figure 2).

3.11 Regarding claims 21, 43 and 66, the Greco reference, modified by Dawson, Greco further teaches transmitting a stored message to client computer 14 (column 5, lines 6-8, 31-35).

3.12 Regarding claim 22 and 67, the Greco reference, modified by Dawson, it is inherent that the information signal is transmitted to client computer 14 when the client computer 14 logged on a local area network 30 in figure 1 (column 3, lines 22-31).

3.13 Regarding claim 36, the Greco reference, modified by Dawson, Greco further teaches that the processor 38, configured as a server, produces the information signal (column 3, lines 22-25, 63-67).

3.14 Regarding claims 37 and 61, the Greco reference, modified by Dawson, Greco further teaches that the processor 38, configured as a server, stores the information signal (column 3, lines 63-67; figure 2).

Art Unit: 2645

3.15 Regarding claim 38, the Greco reference, modified by Dawson, as discussed in claim 1 above, communicates with a sender's computer where the sender's thumbnail picture is stored.

3.16 Regarding claim 39, the Greco reference, modified by Dawson, Greco further teaches that the processor 38, configured as a server, stores the information signal (column 3, lines 63-67; figure 2).

3.17 Regarding claims 40 and 41, the Greco reference, modified by Dawson, the processor 38, configured as a server, inherently has a receiver to receive a request and a generator to process the request for a pending graphical notification when the client computer 14 logged into the network 38.

3.18 Regarding claim 42, the Greco reference, modified by Dawson, the processor 38, configured as a server, inherently has a transmitter to transmit the pending graphical notification to the client computer 14 in the form of the information signal (column 3, lines 63-67; figure 2).

3.19 Regarding claim 50, the Greco reference, modified by Dawson, the processor 38, configured as a server, inherently has a receiver to receive a signal indicating a new message has been received and generates the information signal.

Art Unit: 2645

3.20 Regarding claims 51 and 52, the Greco reference, modified by Dawson, the processor 38, configured as a server, communicates with the client computer 14 (figure 1; column 3, lines 22-31).

3.21 Regarding claims 53 and 54, the Greco reference, modified by Dawson, the client computer has a processor programmed to receive the thumbnail picture from server 38 and display the thumbnail picture on a screen (figure 2).

3.22 Regarding claim 74, the Greco reference, modified by Dawson, teaches selecting a thumbnail picture [indicating that there are more than one pictures] as discussed above in claim 1.

4. Claims 24, 25, 68 and 75 are rejected under 35 U.S.C. 103(a) as being unpatentable over Greco et al. US 5,568,540 in view of Dawson US 6,252,588 and further in view of Picard et al. US 6,233,318.

The Greco reference, modified by Dawson, teaches including a graphical image of the sender of a stored message in the information signal, but fails to teach including a sound waveform in the information signal.

However, Picard discloses a multi-media messaging system in figures 1-6 (column 3, lines 33-62; column 7, lines 13-19). Picard teaches notifying a recipient of a stored message (column 3, lines 50-51), announcing a sender's name to the recipient

Art Unit: 2645

(column 7, lines 20-23, 29-45). Pacard further teaches that audio message can be sent to the recipient in sound wave (column 18, lines 35-42).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to further modify the Greco reference, which was modified by Dawson, with the teaching of Picard so that an audio notification, including the name of a message sender, would have been included in the information signal, because such a modification would have enabled the system to identify the sender without the recipient looking at the thumbnail picture.

5. Claims 26, 28, 49 and 69 are rejected under 35 U.S.C. 103(a) as being unpatentable over Greco et al. US 5,568,540 in view of Dawson US 6,252,588 and further in view of Hsu US 5,907,604.

The Greco reference, modified by Dawson, teaches including a graphical image of the sender of a stored message in the information signal, but fails to specifically teach that the picture is derived from a video frame.

However, Hsu discloses a method and system of an image icon associated with caller ID to identify a calling party (column 4, lines 3-10). Hsu teaches that the image of a calling party can be obtained through a video camera (column 5, lines 16-21).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to further modify the Greco reference, which was modified by Dawson, with the teaching of Hsu so that the image of a sender would have been

Art Unit: 2645

obtain from a video frame taken by a video camera, because selecting an image from a video frame would have been a matter of design choice, and would have given a sender more option to select an image.

6. Claims 27, 76 and 77 are rejected under 35 U.S.C. 103(a) as being unpatentable over Greco et al. US 5,568,540 in view of Dawson US 6,252,588 and further in view of Picard et al. US 6,233,318 and further in view of Hsu US 5,907,604.

The Greco reference, modified by Dawson, teaches including a graphical image of the sender of a stored message in the information signal, but fails to specifically teach that the stored message includes a the picture is derived from a video frame.

However, Picard discloses a multi-media messaging system configured for voice, fax, e-mail and video messages (column 6, lines 29-34). Picard also teaches announcing a sender's name to the recipient in the sender's own voice (column 7, lines 20-23, 29-45). Pacard further teaches that audio message can be sent to the recipient in sound wave (column 18, lines 35-42).

In addition, Hsu discloses a method and system of an image icon associated with caller ID to identify a calling party (column 4, lines 3-10). Hsu teaches that the image of a calling party can be obtained through a video camera (column 5, lines 16-21).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to further modify the Greco reference, which was modified by Dawson, with the teaching of Shaffer and Hsu so that the stored message includes a stream video data, and the image and voice of a sender would have been obtain from

the a video data, because the Greco's system was a multi-media system which inherently would have included video messaging capability, and selecting an image from a video frame would have been a matter of design choice and would have given a sender more option to select an image.

7. Claims 33 and 72 are rejected under 35 U.S.C. 103(a) as being unpatentable over Greco et al. US 5,568,540 in view of Dawson US 6,252,588 and further in view of Dunn 5,651,054 US 5,907,604.

The Greco reference, modified by Dawson, teaches including a graphical image of the sender of a stored message in the information signal, Greco further teaches that if the client computer is connected to the server 39 via network 30, the information of a voice message from a caller being recorded by the server is forwarded to the client computer (column 3, lines 61-67). Greco fails to teach interrupting the storage of the voice message and connecting the caller with a user at the client computer 14.

However, Dunn discloses a method and apparatus for monitoring a message. Dunn teaches that client computer 14 is alerted when an incoming message is being stored (figure 5, reference numeral 161), and a subscriber may click on the TAKE CALL button to interrupt the storage and be connected to the caller (column 6, lines 20-24).

Since the Dunn's system is similar to Greco's, therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to further modify the Greco's reference, which was modified by Dawson with the teaching of Dunn, so that a message status would have been included in the message list and a

Art Unit: 2645

TAKE CALL function would have been added, because such a modification would have enabled a subscriber to screen an incoming voice message, and to answer the call if he or she so desired.

8. Claims 1, 3, 4, 34, 35, 50-56, 58, 59 and 73 are rejected under 35 U.S.C. 103(a) as being unpatentable over Srinivasan US 5,724,412 in view of Sakamaki US 6,317,757.

8.1 Regarding claims 1, 34, 56 and 73, Srinivasan discloses a method and system for displaying Internet identification on customer premises in figures 1A and 1B. Srinivasan teaches recoding a message from a caller [source] with caller's Internet identification, such as network location, home page and FTP address (column 5, lines 9-20; column 2, lines 37-45). The caller's Internet identification [information signal], including a hyperlink, is transmitted to a callee's computer (Internet phone; column 5, lines 54-57) so that the callee can access the caller's home page to get more information about the caller [communication device] for display (column 2, lines 15-27, 37-45). Srinivasan fails to teach that the caller's home page contains a graphical image of the caller.

However, Sakamaki discloses a web page display and teaches that a subscriber's web page includes an image for introducing himself to others (figure 12; column 4, lines 13-18).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to further modify the Srinivasan's reference with the teaching of Sakamaki, so that a caller's home page would have contained a graphical image associated with the caller, because such a modification would have enabled a callee to identify the caller immediately.

8.2 Regarding claim 3, 4, 35, 58 and 59, the Srinivasan reference, modified by Sakamaki, teaches identify the caller's Internet identification, and including the caller's Internet identification in the information signal as discussed above.

8.3 Regarding claims 24, 25, 68 and 75, the Srinivasan reference, modified by Sakamaki, Srinivasan further teaches that the caller's identification can be represented to the callee's computer in audio format (column 2, lines 27-32; column 8, lines 9-13).

9. Claims 29, 30, 47 and 70 are rejected under 35 U.S.C. 103(a) as being unpatentable over Greco et al. US 5,568,540 in view of Dawson US 6,252,588 and further in view of Brunson et al. US 6,038,296.

The Greco reference, modified by Dawson, teaches including a graphical image of the sender of a stored message in the information signal, but fails to teach adding portion the information signal to a web page accessible to the communication device signal.

However, Brunson discloses a method for sending an email by presenting a recipient's [subscriber] web page to a sender [user]. The sender then enters his name and email address onto the web page (figure 7; column 4, lines 33-41; column 5, lines 29-45, 64-67).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Greco's system, which was modified by Dawson, with the teaching of Brunson so that a portion of the information signal, such as the sender's name and return address would have been added to a recipient's web page, because such a modification would have enabled a recipient to be notified about a stored message when he logged into the Internet.

Response to Arguments

10. Applicant's arguments with respect to claims 1-77 filed on 11/27/2002 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Simon Sing whose telephone number is (703) 305-3221. The examiner can normally be reached on Monday - Friday from 8:30 AM to 5:30 PM.

Art Unit: 2645

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang, can be reached at (703) 305-4895. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9314.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4750.

FAN TSANG
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600



S.S.

01/30/2003